

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES W. KENNEY

Appeal No. 95-3317
Application 07/937,522¹

ON BRIEF

Before LYDDANE, MEISTER and ABRAMS, Administrative Patent Judges.

LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection
of claims 12 through 27, which are all of the claims pending

¹ Application for patent filed August 27, 1992. According to appellant, this application is a division of Application 07/382,547, filed July 19, 1989, now Patent No. 5,173,266, issued December 22, 1992.

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in the application.

The subject matter on appeal is directed to a process for making a safety pipet tube. Claim 12 is exemplary of the invention and reads as follows:

12. A process for making a safety pipet tube comprising the steps of

taking an elongated glass tube having an outer surface, an axial bore with an inner surface, and upper and lower ends which are open,

taking a resilient sheet having an inner layer of adhesive,

heating the sheet until the adhesive layer becomes tacky,

rolling the tube over the adhesive layer to wrap the sheet around the tube to form a protective wrapping for the tube with an inner layer of the sheet wrapped around the outer surface of the tube and an outer layer of the sheet wrapped around the inner layer of the sheet,

adhering the resilient sheet to the outer surface of the tube and to the inner layer of the sheet, and

allowing the wrapped tube to cool to room temperature,

whereby to provide a safety glass tube pipet which protects a user from injury and infection should the glass tube break and form jagged edges which could cut the user were it not for the protection provided by the resilient sheet.

The references of record relied upon by the examiner in rejections of the claims under 35 U.S.C. § 103 are:

Nitzsche et al. (Nitzsche)	3,230,121	Jan. 18,
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1966		
Cavanagh et al. (Cavanagh)	3,955,020	May 4,
1976		
Vohrer	4,495,018	Jan. 22,
1985		

Claims 12, 13, 19, 20, 26 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nitzsche in view of Vohrer.

Claims 14 through 18 and 21 through 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nitzsche in view of Vohrer and Cavanagh.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by the examiner and the appellant, we refer to pages 2 through 9 of the examiner's answer (Paper No. 10), to the supplemental answer (Paper No. 12), to pages 4 through 25 of the appellant's brief (Paper No. 9) and to the reply brief (Paper No. 11)² for the full exposition thereof.

² The appellant's supplement reply brief (Paper No. 13) was not approved for entry by the examiner and consequently has not been considered by this panel of the Board of Patent Appeals

OPINION

In arriving at our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art, and to the respective positions advanced by the appellant and by the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to all claims on appeal. Our reasoning for this determination follows.

Considering first the examiner's rejection of claims 12, 13, 19, 20, 26 and 27 under 35 U.S.C. § 103 as being unpatentable over Nitzsche in view of Vohrer, we are in substantial agreement with the examiner's position with respect to the patent to Nitzsche that a protective and heat insulating covering for a frangible, impact-sensitive article such as glass tubing is disclosed thereby, with the covering formed by wrapping the glass tubing with self-adhering elastomeric materials such as silicone rubbers. Other

and Interferences.

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materials with similar characteristics may be employed (column 2, lines 14-52), and the silicone rubbers may be prepared as either "transparent tapes or sheets" (column 2, line 62).

Moreover, Nitzsche clearly discloses that the wrapping of the glass tubing has the advantage that "glass splinters and other glass pieces tend to be held in place even if the glass breaks during operation" (column 3, lines 42-44).

However, all of the independent claims on appeal require, inter alia, the steps of "taking a resilient sheet having an inner layer of adhesive, heating the sheet until the adhesive layer becomes tacky, rolling the tube over the adhesive layer to wrap the sheet around the tube," none of which are disclosed or suggested by Nitzsche. The examiner has applied the teachings of the patent to Vohrer as evidence of the obviousness of modifying the process of Nitzsche to include the missing steps noted above, and admittedly, Vohrer discloses utilizing a textile reinforced strip 10 with a hot melt adhesive, the strip being wound around an inner tube. However, the inner tube is not "glass" as asserted by the examiner on page 3 of the answer, but is made of "thermoplastic or elastomeric material" (column 2, lines 46-47

and paragraph (a) of claim 1) or PVC (column 5, line 27) that is extruded from a nozzle 1 (Figure 1) to form the tube (note Figure 1; column 5, lines 26-27; and paragraph (a) of claim 1). Furthermore, Vohrer discloses wrapping the strip 10 around the tube, then heating the wrapped tube by passing the wrapped tube through a first heating zone 11 to adhere the strips 10 to underlying longitudinal reinforcing strips 6 (note column 6, lines 5-8 and Figure 1).

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). A prima facie case of obviousness is established by presenting evidence indicating that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some

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objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988), In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986) and ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Additionally, rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). Our reviewing court has

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repeatedly cautioned against employing hindsight by using the applicant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings in the prior art. See, e.g., Grain Processing Corp. v. American Maize- Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

It is our opinion that the examiner has not provided a sufficient factual basis from which to conclude that appellant's claimed invention as a whole including the differences noted above between the independent claims on appeal and the process of Nitzsche would have been obvious to one having ordinary skill in the art in view of the teachings of Vohrer. In particular, Vohrer fails to even teach the steps of (1) "taking a resilient sheet having an inner layer of adhesive", (2) "heating the sheet until the adhesive layer becomes tacky", or (3) "rolling the tube over the adhesive layer to wrap the sheet around the tube" (emphasis added), all required by the independent claims on appeal.

Furthermore, as stated in W.L. Gore & Assocs. Inc. v.

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Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313

(Fed. Cir. 1983),

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

It is our further opinion that the only reason to combine the teachings of the patents to Nitzsche and Vohrer in the manner proposed by the examiner results from a review of appellant's disclosure and the application of impermissible hindsight.

We find nothing in the disclosure of the reinforced extruded plastic tubing of Vohrer that would have suggested utilizing the textile reinforced strip with hot melt adhesive as a substitute for the self-adhering silicone rubber wrap of Nitzsche. Moreover, even assuming that one having ordinary skill in the art would have found it obvious to modify the process of Nitzsche with the textile reinforced strips having hot melt adhesive taught by Vohrer, the process ensuing from such modification would not result in appellant's claimed invention because it would not include steps (1) through (3)

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noted above.

Thus, we cannot sustain the examiner's rejections of appealed claims 12, 13, 19, 20, 26 and 27 under 35 U.S.C. § 103 as being unpatentable over Nitzsche in view of Vohrer. Furthermore, we have considered the additional teachings of Cavanagh as applied in the rejection of appealed claims 14 through 18 and 21 through 25, but we find nothing therein to overcome the deficiencies of the combined teachings of Nitzsche and Vohrer. Therefore, we also cannot sustain the examiner's rejection of these claims under 35 U.S.C. § 103. Since we have concluded that the examiner has not established a prima facie case of obviousness with respect to the claims on appeal, we have not found it necessary to consider the evidence of non-obviousness presented in the declaration of James W. Kenney, appellant.

We make the following new rejection pursuant to the provisions of 37 CFR § 1.196(b).

Claims 26 and 27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention.

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Claim 26 is directed to a "process for making a disposable one-time use, inexpensive, safety pipet tube." The second through eighth paragraphs of this claim recite steps involved in making the tube, but the remainder of the claim, beginning with "drawing a liquid sample into the tube," as well as all of claim 27 dependent therefrom, is directed to a method of using the pipet tube. Thus, the remainder of claim 26 noted above, along with claim 27, is inconsistent with the "process for making" recited in the preamble of claim 26 thereby rendering claims 26 and 27 confusing. We recognize the inconsistency implicit in our holding that claims 26 and 27 are rejectable under 35 U.S.C.

§ 112, second paragraph, as failing to particularly point out and distinctly claim the invention with the holding on the other hand that the prior art fails to render the claimed invention obvious. Normally when substantial confusion exists as to the interpretation of the claims and no reasonably definite meaning can be ascribed to terms in the claim, a determination with respect to the issue of obviousness is not made. See In re Steele, 305 F.2d 859, 863 134 USPQ 292, 295 (CCPA 1962) and

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In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). However, in this instance, we consider it to be desirable to avoid the inefficiency of piecemeal appellate review. See

Ex parte Ionescu, 222 USPQ 537, 540 (Bd. App. 1984).

Therefore, we have made the determination as to the nonobviousness of the claims on appeal in the interest of judicial economy based on our conclusion that the combined teachings of the prior art would not have rendered the process for making the pipet tube recited in claims 26 and 27 prima facie obvious for the reasons stated above.

Accordingly, the decision of the examiner rejecting claims 12 through 27 under 35 U.S.C. § 103 is reversed, and we have made a new rejection of claims 26 and 27 pursuant to the provisions of 37 CFR § 196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision. 37 CFR § 1.197. Should appellant elect to have further prosecution before the examiner in response to the new rejection under 37 CFR § 1.196(b) by way

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of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED, 37 CFR § 1.196(b)

William E. Lyddane)
Administrative Patent Judge)
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PATENT	James M. Meister) BOARD OF
	Administrative Patent Judge) APPEALS AND
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